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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/196,916	11/20/1998	ALBERT RUMBACH	364/51	9688

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EXAMINER

MCNEIL, JENNIFER C

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 06/12/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

49-17

Office Action Summary

Application No.

09/196,916

Applicant(s)

RUMBACH ET AL.

Examiner

Jennifer McNeil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-8 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8 and 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3-8 and 11-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to define the metal alloy facing in notation of weight percent. As stated previously, the specification does not disclose whether the alloy is noted in weight or atomic percent. Therefore this addition to the claims is considered new matter.

Claims 3-8 and 11-17 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The proper notation of the percentages, whether atomic or weight, of the alloy is critical or essential to the practice of the invention, but not included in the claims (s) is not enabled by the disclosure (See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976)). The specification and claims fail to disclose whether the alloy is reported in atomic or weight percent. The omission renders the claims not enabled.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or render obvious an electrically conductive metal strip for the production of electrical components comprising a core strip made of copper material; and a metal facing made of a copper-nickel-zinc alloy, roll-bonded clad on at least one side of the strip, the metal facing consisting of CuNi19Zn27 by

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weight percent. The prior art also does not teach or render obvious a metal facing of the above strip with a composition consisting of CuNi₁₈Zn₂₀, or CuNi₁₂Zn₂₄ by weight percent.

Response to Arguments

Applicant's arguments filed October 29, 2002 have been fully considered but they are not persuasive.

Applicant has amended the specification and has obviated the new matter objection of March 13, 2001.

Regarding the claims, applicant has argued that one of ordinary skill in the art would have recognized that the alloy of the instant specification would have known that the composition of the alloys were described in terms of percentage-by-weight. Applicant points to Table 1 of the instant specification and the use of the terms "%" and "remainder" and states that these are commonly used to recite compositions in weight percent. Applicant also points to notations of page 4 of the instant specification. Applicant also refers to Exhibits 1-3, submitted July 12, 2000, that show copper alloys without any reference to the basis. Applicant argues that one of ordinary skill would recognize that the percentages are weight basis because it is customary to express compositions of alloys on a percentage-by-weight basis with references to "percentages" or "%". And Exhibit 3 refers to an aluminum alloy that also does not note the basis of composition. Essentially, it appears that applicant is arguing that in the absence of notation, one skilled in the art would understand a notation of "%" means "weight %".

This argument is not considered persuasive. Firstly, as shown by US Patents 5,296,653; 5,236,789; 4,497,527; 4,925,407; and 5,967,860, note alloys in atomic percent by using the term "%". US 5,296,653 also uses "atomic %" notation with the term "balance" (see claims). "Balance" is considered to be commensurate with "remainder". Also, US 5,236,789 gives a side-by-side comparison of alloys with similar notation, as shown in Table 1. Table II gives no notation of the basis for the composition.

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Furthermore, these alloys are used in the applications similar to that of the instant specification.

Regarding applicant's exhibits, lack of notation by references does not negate the simple fact that alloys are and can be noted in different fashions. The above-mentioned references clearly show that alloys may be noted in weight percent or atomic percent. Applicant's submission of a few references that do not give notations does not show that one of ordinary skill would simply assume the notation is meant in weight percent. Therefore, it is not clear that one of ordinary skill would understand that applicant's alloy is meant only in weight percent, simply because applicant states that this is customary in the art. The above references give evidence that notation in atomic percent is also well-known in the art.

Regarding the patent of Exhibit 3, a commercial alloy is referred to prior to the disclosure of the composition of the alloy. The comparison to a commercial alloy directs one of skill to whether the percentages would be weight or atomic percent, since the commercial alloy may be looked up in a reference manual.

The rejection under 112, first paragraph is held.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer McNeil whose telephone number is 703-305-0553. The examiner can normally be reached on Monday through Friday, 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 703-308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



JCM
June 4, 2003

Jennifer McNeil
Examiner
Art Unit 1775


DEBORAH JONES
SUPERVISORY PATENT EXAMINER